

Serial No. 10/053,410  
Amendment Dated 07/27/2004  
Reply to Office Action of 01/30/2004

#### REMARKS/ARGUMENTS

Claims 1-79 are pending in the application. Claims 6, 17, and 21-79 are withdrawn as belonging to a non-elected invention. Claims 2, 5, 13, 16, 19, and 20 have been cancelled without prejudice or disclaimer. Applicants expressly reserve the right to file divisional applications or take such other appropriate measures deemed necessary to protect the subject matter of cancelled claims. Claims 1, 3, 4, 8-10, 14, 15, and 18 have been amended. The amendments are supported by the original claims and throughout the specification. No new matter has been added by way of amendment.

Reexamination and reconsideration of the application as amended are respectfully requested.

#### Claim Objections

Claims 1-5, 10, 13-16, and 18 are objected to for reading on non-elected inventions. Claims 2, 5, 13, and 16 have been cancelled without prejudice. Claims 1, 3, 4, 8-10, 14, 15, and 18 have been amended to delete the non-elected sequences.

Claim 1, line 11 is objected to for not reciting "and" after "(c)". Claim 1 has been amended and now includes the word "and".

Claim 10, line 13 is objected to for not reciting "and" after "(c)". Claim 10 has been amended and now includes the word "and".

Claim 13, line 3 is objected to for not reciting "and" after "(c)". Claim 13 has been cancelled without prejudice.

Claim 18, line 13 is objected to for not reciting "and" after "(c)". Claim 18 has been amended and now includes the word "and".

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#### **Rejections under 35 USC §112, second paragraph**

Claims 1,2, 5, 7-13, 16, and 18-20 are rejected under 35 USC §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Office Action states: "Claim 1 is indefinite in the recitation 'a nucleotide sequence encoding a polypeptide having at least about 80% sequence identity to the nucleotide sequence'. It is not clear if Applicant is claiming a nucleotide sequence exhibiting at least about 80% sequence identity compared to another nucleotide sequence, or Applicant is claiming a nucleotide sequence encoding a protein that exhibits at least about 80% sequence identity to another protein sequence, or Applicant is claiming a nucleotide sequence encoding a protein exhibiting at least about 80% sequence identity to a nucleotide sequence."

Claim 1 has been amended to remove the limitation of "80% sequence identity". It is believed the amendment obviates the rejection.

Claims 1, 5, 10, 16, and 18 are rejected as indefinite because "stringent" is a relative term.

The Office Action states: "The term 'stringent conditions' is not explicitly defined by the claim or the specification".

Claim 5 has been cancelled. Claims 1, 10, 16, and 18 have been amended to remove the limitation of "hybridizing under stringent conditions". It is believed the amendment obviates the rejection.

#### **Rejections under 35 USC §112, first paragraph**

Claims 1, 2, 5, 7-13, 16, and 18-20 are rejected under 35 USC §112, first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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The Office Action states: "The claims are drawn to an isolated nucleic acid molecule, transformed plant, or transformed plant cell, comprising a nucleotide sequence exhibiting at least 80% sequence identity with SEQ ID NO:3, an isolated nucleic acid molecule comprising a nucleotide sequence that hybridizes to SEQ ID NO:3, ... or a nucleotide sequence encoding SEQ ID NO:4; or expression cassette comprising a nucleotide sequence exhibiting at least 80% sequence identity with SEQ ID NO:3 ... Applicants do not describe any polynucleotide sequence that hybridize to SEQ ID NO:3 or any sequence that exhibit at least 80% sequence identity to SEQ NO:3 and encode an 18kD  $\alpha$ -globulin protein."

Claims 2, 5, 13, 16, 19, and 20 have been cancelled without prejudice. Claims 1, 10, and 18 have been amended to remove the limitations to "80% sequence identity" and "hybridizing under stringent conditions". Claims 7, 8, and 9 depend from amended claim 1. Claims 11 and 12 depend from amended claim 10. It is believed the amendments obviate the rejection and place the claims in condition for allowance.

Claims 1, 2, 5, 7-13, 16, and 18-20 are rejected under 35 USC §112, first paragraph, because the specification does not enable any person skilled in the art to which it pertains to make or use the invention as claimed.

The Office Action states: "... the specification ... does not reasonably provide enablement for claims drawn to an isolated nucleic acid molecule, comprising any nucleotide sequence exhibiting at least 80% sequence identity with SEQ ID NO:3; any isolated nucleic acid molecule comprising a nucleotide sequence that hybridizes to SEQ ID NO:3; or expression cassette comprising a nucleotide sequence exhibiting at least 80% sequence identity with SEQ ID NO:3 or nucleotide sequence that hybridizes to SEQ ID NO:3 or a sequence that encodes SEQ ID NO:4, or plant, plant cell or seed transformed therewith."

Claims 2, 5, 13, 16, 19, and 20 have been cancelled without prejudice.

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Claims 1, 10, and 18 have been amended to remove the limitations to "80% sequence identity" and "hybridizing under stringent conditions". Claims 7, 8, and 9 depend from amended claim 1. Claims 11 and 12 depend from amended claim 10. It is believed the amendments obviate the rejection and place the claims in condition for allowance.

#### Rejections under 35 USC §101

Claim 19 is rejected under 35 USC §101 as being directed to non-statutory subject matter.

Claim 19 has been cancelled without prejudice or disclaimer. It is believed the cancellation obviates the rejection.

#### Rejections under 35 USC §102

Claims 1 and 5 are rejected under 35 USC §102(b) as being anticipated by Shorosh *et al.*

The Office Action states: "Shorosh *et al* teach a nucleic acid sequence that exhibits 18% sequence identity to SEQ ID NO:3 and hybridizes to SEQ ID NO:3. Because of the 112 2nd indefiniteness of 'stringent conditions' as discussed above, the Office interprets the phrase to encompass any hybridization conditions. Hence, the sequence disclosed by Shorosh *et al* anticipates the claimed invention."

Claim 5 has been cancelled without prejudice. Claim 1 has been amended to remove the limitation "hybridizing under stringent conditions". It is believed the cancellation and amendment obviate the rejection.

Claims 1, 7, 10-12, 16, and 18-19 are rejected under 35 USC §102(b) as being anticipated by Singh *et al.*

The Office Action states: "Singh *et al* teach a rice plant transformed with a legumin seed storage protein. Because of the 112 2nd indefiniteness of 'stringent conditions' as discussed above, the Office interprets the phrase to encompass any

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hybridization conditions, and as such, the sequence of Singh et al hybridizes to a sequence exhibiting at least 80% sequence identity to SEQID NO:3 .... It would be an inherent component of the system to generate seeds, and as such, Singh et al anticipate the claimed invention."

Claim 19 has been cancelled without prejudice. Independent claims 1, 10, and 18 have been amended to remove the limitation "hybridizing under stringent conditions". Claims 7, 11, 12, and 16 depend from the amended claims. It is believed the cancellation and amendment obviate the rejection.

#### CONCLUSION

In view of the above amendments and remarks, it is submitted that the rejections of the claims under 35 USC §102 and 112 are overcome. It is respectfully submitted that this application is now in condition for allowance. Early notice to this effect is solicited.

Respectfully submitted,



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